

ELECTRONIC FILING

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/823,847
Entitled: : MIKE 8001 INDUCTION MOTOR DESIGN
Applicant : Yue-Chung Chen
Filed : April 14, 2004
Art Unit : 2834
Examiner : Nguyen, Hahn N

Docket No.: : CHEN-74813
Customer No. : 24201

PETITION FROM RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant hereby petitions the Director to review and reverse the restriction requirement that was made final in this case. *See* 37 C.F.R. § 1.144; *see also* MPEP 821.01 and 1002.02(c).

Applicant respectfully submits that no fees are required in connection with this petition. Nonetheless, the Commissioner is authorized to charge any additional fees that may be required by this paper to Deposit Account No. 06-2425.

BACKGROUND

In the prior Office action mailed on March 13, 2007, a restriction was required between claims 3-7 (Group I), claims 8-13 (Group II), or claims 14-19 (Group III). A listing of these claims is attached to this petition.

In a response dated April 13, 2007, Applicant elected Group I, with traverse. Applicant asserted that there was no serious burden on the Examiner to examine all of the claim groups because all of the claims recite a “shell” as part of the claimed invention, and the Examiner's own classification of the claimed inventions suggested the same field of search.

In the Office action mailed on July 10, 2007, the Examiner asserted that the restriction was proper, and made the restriction requirement final.

DISCUSSION

Applicant requests reconsideration and withdrawal of the restriction requirement. Restriction is proper only where the Examiner can show that there would be a “serious burden” on the Examiner if restriction is not required. *See* MPEP 808.02. A critical inquiry is whether each invention has a separate classification with a corresponding separate field of search, or whether each invention has a different field of search such that it would be necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention. *See* MPEP 808.02.

All Claims Recite a “Shell”

Applicant notes that claim 3 (Group I) and claim 8 (Group II) both recite a “shell.” And method claim 14 (Group III) recites the step of “forming a shell.” The same field of search would be required for these groups of claims.

In response, the Examiner asserted that the Group I claims recited “a shell” and the Group II claims recited “a shell forming a closed space,” such that the respective fields of search would be different. The Examiner further asserted that the step of “forming the shell around the rotor” in the method claims of Group III could be used to make a different product such as “a torque tube for superconductor motor.”

Regarding the Examiner’s first point, Applicant respectfully submits that the field of search for “a shell” and “a shell forming a closed space” would overlap since both

recite a “shell.” Accordingly, the overlapping fields of search would be neither separate nor different. A search for one of the inventions would likely result in finding art pertinent to the other invention.

Regarding the Examiner’s second point that the method claims of Group III could be used to make a different product such as “a torque tube for superconductor motor,” Applicant notes that for the restriction requirement to be proper, the Examiner would have to show that “the process as claimed can be used to make another materially different product.” *See* MPEP 806.05(f). Applicant respectfully submits that the Examiner has not made the required showing where claim 3 in Group I recites an induction motor as a limitation of the invention.

Since it would not be necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention, Applicant respectfully submits that it would not be a serious burden for the Examiner to examine all of the claimed inventions together in the same application.

The Classification of the Claim Groups Suggests the Same Field of Search

Moreover, the Examiner has not addressed Applicant’s argument that the Examiner’s own classification of the claim groups suggests the same field of search for those groups of claims.

In the original restriction requirement, the Examiner has alleged that the Group I claims are classified in class 310, subclass 89; and that the Group II claims are classified in class 310, subclass 166. However, as will be explained below, both groups of claims would require the same field of search based on their classifications.

The Manual of Patent Classification defining class 310 states that this is a “residual class for all subject matter, not elsewhere classified, relating to electrical generator or motor structure.” In particular, the Manual of Patent Classification states (with emphasis added) that:

... in making a thorough search in this [310] class, it is advisable to investigate every subclass which may possibly be pertinent and not, in order to shorten the search, to rely upon the principle of superiority of subject matter because of position in the schedule, since that principle is applicable only in classes where each patent has been analyzed and placed in the schedule in accordance with that portion of the disclosed subject matter which is claimed.

Thus, the field of search for Group I will likely also include the field of search for or Group II, and vice versa. The Manual of Patent Classification further notes that:

(2) Note. Since Class 310 takes, under the class definition, only subject matter relating to electrical generator or motor structure not elsewhere classified, its scope can be determined only by determining the scope of other related classes, which classes are listed below under search class. Also consult the search notes in the definitions of these classes.

(3) Note. Many mechanical classes contain electrical disclosures, as where an electrical machine is disclosed in a mechanical environment, with which it cooperates. Consequently, in appropriate instances, the search must extend to the class or classes which relate to the environment in which the electrical disclosure may be found.

By the nature of Class 310 being a “residual” classification, where “it is advisable to investigate every subclass which may possibly be pertinent,” and the fact that all of the claims recite a “shell,” the fields of search would be neither separate nor different. Rather, the same field of search would be required for these groups of claims.

CONCLUSION

The Examiner has failed to establish that it would a serious burden to examine all three groups of claims. See MPEP 808.02. Applicant respectfully requests that the restriction requirement be withdrawn, and that claims 8-13 (Group II) and claims 14-19 (Group III) be examined along with the elected claims 3-7 (Group I).

Applicant respectfully requests favorable reconsideration of the restriction requirement. If any question arises, kindly telephone the undersigned.

Respectfully submitted,

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